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919 7590 04/02/2008 PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000				
			EXAMINER DANG, KHANH	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

09/801,725

## Applicant(s)

KING ET AL.

## Examiner

Khanh Dang

## Art Unit

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Notice to Applicants*

A review of the record shows that the numerous supplemental papers in the application file appears to confuse the Board of Appeals in reviewing the application. In order to ensure that the record of prosecution is clearly stated, and that the Applicant is not unduly prejudiced in their ability to properly respond to the outstanding rejections of the claims, the Examiner hereby reopens prosecution in order to establish a clear basis for the rejections of the claims in the record.

### *Claim Rejections - 35 USC § 112*

Claims 8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8, line 4, the phrase, "sending an email using physical address of a recipient" is unclear. As disclosed, an email is sent to a recipient using e-mail address after matching the recipient's physical address with the recipient's e-mail address.

In claim 10, lines 12-13, the phrase, "the physical address of said buyer is used to send said email" is unclear. As disclosed, an email is sent to a recipient using e-mail address after matching the recipient's physical address with the recipient's e-mail address.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 11, 13, 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan.

With regard to claims 1, 5, and 14, Hogan discloses a system for routing e-mails, comprising: a server (160, column 4, lines 36-44; column 9, lines 50-60; column 5, lines 22-36, for example) that includes a database, the database including a physical addresses and e-mail addresses of subscribers or recipients; in Hogan, each regular mail of a subscriber or recipient has a corresponding email address, wherein the server (160) is connected to a network (internet network 110, for example), the server (160) further including an electronic mailbox (email box) for each physical address (regular mail, each subscriber or recipient must enter a physical address and email address into the data base of the server 160, see at least column 5, lines 25-35), wherein the electronic mailbox is associated with an account number and password (see at least Fig. 2a and description thereof; column 5, line 62 to column 6, line 8; column 10, lines 40-46); and a recipient host (PC 100 employed by a subscriber or recipient, for

example) that includes a web browser, the recipient host connected to the network (110), wherein the host can access e-mails on the server (160) using the account number and the password. With regard to claim 2, it is clear that in Hogan, the recipient can print the email from the server (160), or the email can be printed and sent to the subscriber or recipient via regular mail if the subscriber or recipient chooses not to electronically make a payment by exiting the payment page. The recipient can also choose not to open the email, and as a result, the e-mail be printed and forwarded to the recipient via regular mail. With regard to claim 3, as discussed in claim 2, it is clear that the server (160) provides a graphical user interface (see Figs. 3 and 4, for example) that allows a recipient to select whether electronic mail is delivered to the electronic mailbox by selecting "203, receive and pay bill"; or is delivered via traditional mail by choosing not to electronically make a payment by exiting the payment page, or the recipient can also choose not to open the email, and as a result, the e-mail be printed and forwarded to the recipient via regular mail. With regard to claim 4, at the outset, in claim 4, line 4, before "to forward," the word "recipient" is a typo error and should be changed to -server -. It is clear that the server 160 includes a host mail with web browser, and the host mail includes a graphical user interface to forward email 107, Fig. 11, for example) to a recipient. With regard to claim 11, it is clear that the address of a user stored in a database can always be edited. With regard to claim 13, as discussed above, it is clear that each recipient is assigned with an email box. With regard to claim 16, it is clear that emails can be printed and mailed via traditional mail. Furthermore,

Hogan discloses that physical address and email address of a recipient are stored in a database.

Hogan does not disclose a means for mapping a physical address of a recipient to an email address of the recipient.

However, mapping a physical address to an email address is old and well-known in the art as evidenced by Infospace, cited in the previous Office Action. Infospace provides an option of mapping a physical address to an email address; or in other words, searching a person's email address using a person's physical address in a database comprising the person's physical address and email address. The following is a screenshot showing a typical search engine mapping an email address to a physical address:



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To further support the fact that Infospace Search Engine is old, well-known, and qualified as an effective prior art, the following documents is provided showing the search engine has been used since at least 1997:

The Ultimate Email Directory, 1997, features Infospace, among other similar Email Search Engines, to provide mapping a physical address to an email address. A screenshot is provided below:



The Ultimate Email Directory - Microsoft Internet Explorer provided by USPTO

Back Stop Refresh Home Search Favorites History Mail Print Edit Discuss Windows...  
Links to: USPTO Internet Homepage Customized Links Free Hotmail Windows Windows Media  
Address: http://web.archive.org/web/19960117035142/http://www.theultimates.com/email/  
Change Search Check Autolink Outlook

File Edit View Favorites Tools Help

# THE ULTIMATE EMAIL DIRECTORY

[New Users](#)

[ Home | White Pages | Yellow Pages | Email Directory | Trip Planner | Compliments and Awards ]

Four11:	WhoWhere:	IAF:	InfoSpace:	Bigfoot:	ESP:
Last: <input type="text"/>	Name: <input type="text"/>	Last: <input type="text"/>	Last: <input type="text"/>	Name: <input type="text"/>	Name: <input type="text"/>
First: <input type="text"/>	Domain: <input type="text"/>	First: <input type="text"/>	First: <input type="text"/>	<input type="button" value="Search"/>	<input type="button" value="Search"/>
City: <input type="text"/>	<input type="button" value="Search"/>	Organization: <input type="text"/>	City: <input type="text"/>	<input type="button" value="Search"/>	<input type="button" value="Reset All"/>
State: <input type="text"/>		Domain: <input type="text"/>	State: <input type="text"/>		
Country: <input type="text"/>		<input type="button" value="Search"/>	Country: <input type="text"/>		
Organization: <input type="text"/>		Reverse (IAF): <input type="text"/>	<input type="button" value="Search"/>		
Domain: <input type="text"/>		Email: <input type="text"/>			
<input type="button" value="Search"/>		<input type="button" value="Search"/>			

## Newcomers:

Welcome to the Ultimate Email Directory!

*Have you ever lost an important email address?*  
We all have. Trying to find it is frustrating. There are six different email directories on the Internet, all with different data sources and different degrees of accuracy. The Ultimate Email Directory is a common interface to all six.

This site is designed to be fast and simple. Just type your search criteria into the first search engine (Four11). Type in all the items you know. The items applicable to the other engines will be automatically copied to the other forms by a Javascript applet. Then hit Search on the first search engine you want to query. A new browser window will open with the search results. Then switch back to the original window and hit submit on the next one. You can search as many as you want until you are satisfied with the results.

*Questions?*  
Read the FAQ. If you don't find an answer, email me.

-----  
Email Directory Administrators: Don't want your engine used on this page? Or do you want more credit for it? I'll be happy to change my page if you want me to.

page made and administered by Scott Martin

This page has been accessed 119425 times since May 31, 1997.

Legal Gibberish with Translations

The Ultimates are ©1997 by Scott Martin.

Start 6 M. 12 I Win... 3 R. My... eDA... 2 M. 4 E. 3 M. 2:55 PM

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of mapping a physical address to an email address; or in other words, searching a recipient's email address using a recipient's physical address in a data base comprising a recipient's physical address and email address, since the Examiner takes Official Notice that mapping a physical address to an email address; or in other words, searching a recipient's email address using a person's physical address in a data base is old and well-known as evidenced by at least Infospace, cited in the previous Office Action; and providing such a search capability to the e-commerce server 106 of Hogan, since a search engine is important and vital to the success of e-commerce, only involves ordinary skill in the art.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan as applied to claim 5 above, and further in view of Daniels, Jr. et al. (6,343,327).

The further difference between Hogan and the claimed subject matter is the method of selectively tagging or identifying a particular class of emails for delivering either electronically or via traditional mail. Daniel, Jr. et al. discloses a method of sorting emails based on method of delivery and delivery designated emails via either postal mail or email (see at least Figs. 1 and 2, and description thereof). In particular, the print stream processor 102 selectively tags or identifies a particular class of emails based on the customer database delivery preference 202, for delivering either electronically via

electronic inserter 110 or via traditional mail via physical inserter 106. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of sorting mails and delivering mails based on a recipient's choice via either email or traditional mail, as taught by Daniels, Jr. et al., for the purpose of upgrading the mail system of Hogan by adding capabilities (see Daniels Jr., et al., col. 1, lines 61-64) to the mail server of Hogan.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Daniel Jr. et al.

Hogan discloses a system for routing e-mails, comprising: a server (160, column 4, lines 36-44; column 9, lines 50-60; column 5, lines 22-36, for example) that includes a database, the database including a physical addresses and e-mail addresses of subscribers or recipients; in Hogan, each regular mail of a subscriber or recipient has a corresponding email address, wherein the server (160) is connected to a network (internet network 110, for example), further including an electronic mailbox (email box) for each physical address (regular mail, each subscriber or recipient must enter a physical address and email address into the data base of the server 160, see at least column 5, lines 25-35), wherein the electronic mailbox is associated with an account number and password (see at least Fig. 2a and description thereof; column 5, line 62 to column 6, line 8; column 10, lines 40-46); and a recipient host (PC 100 employed by a subscriber or recipient, for example) that includes a web browser, the recipient host connected to the network (110), wherein the host can access e-mails on the server

(160) using the account number and the password. Further, it is clear that in Hogan, the recipient can print the email from the server (160) and send using regular mail. The recipient can also choose not to open the email, and as a result, the e-mail be printed and forwarded via regular mail. Also, it is clear that the server in Hogan, the recipient can print the email from the server (160), or the email can be printed and sent to the subscriber or recipient via regular mail if the subscriber or recipient chooses not to electronically make a payment by exiting the payment page. The recipient can also choose not to open the email, and as a result, the e-mail be printed and forwarded to the recipient via regular mail. With regard to claim 3, as discussed in claim 2, it is clear that the server (160) provides a graphical user interface (see Figs. 3 and 4, for example) that allows a recipient to select whether electronic mail is delivered to the electronic mailbox by selecting "203, receive and pay bill"); or is delivered via traditional mail by choosing not to electronically make a payment by exiting the payment page, or the recipient can also choose not to open the email, and as a result, the e-mail be printed and forwarded to the recipient via regular mail, and payment confirmation is sent to the recipient and sender. Furthermore, Hogan discloses that physical address and email address of a recipient are stored in a database.

Hogan does not disclose a means for mapping a physical address of a recipient to an email address of the recipient.

However, mapping a physical address to an email address is old and well-known in the art as evidenced by Infospace, cited previously and also below. Infospace provides an option of mapping a physical address to an email address; or in other

words, searching a person's email address using a person's physical address in a data base comprising the person's physical address and email address.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of mapping a physical address to an email address; or in other words, searching a recipient's email address using a recipient's physical address in a data base comprising a recipient's physical address and email address, since the Examiner takes Official Notice that mapping a physical address to an email address; or in other words, searching a person's email address using a person's physical address in a data base is old and well-known as evidenced by at least Infospace, cited in the previous Office Action; and providing such a search capability to the e-commerce server 106 of Hogan, since a search engine is important and vital to the success of e-commerce, only involves ordinary skill in the art

The further difference between Hogan and the claimed subject matter is the method of selectively tagging or identifying a particular class of emails for delivering either electronically or via traditional mail. Daniel, Jr. et al. discloses a method of sorting emails based on method of delivery and delivery designated emails via either postal mail or email (see at least Figs. 1 and 2, and description thereof). In particular, the printstream processor 102 selectively tags or identifies a particular class of emails based on the customer database delivery preference 202, for delivering either electronically via electronic inserter 110 or via traditional mail via physical inserter 106. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of sorting mails and delivering mails based

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on a recipient's choice via either email or traditional mail, as taught by Daniels, Jr. et al., for the purpose of upgrading the mail system of Hogan by adding capabilities (see Daniels et al., col. 1, lines 61-64) to the mail server of Hogan.

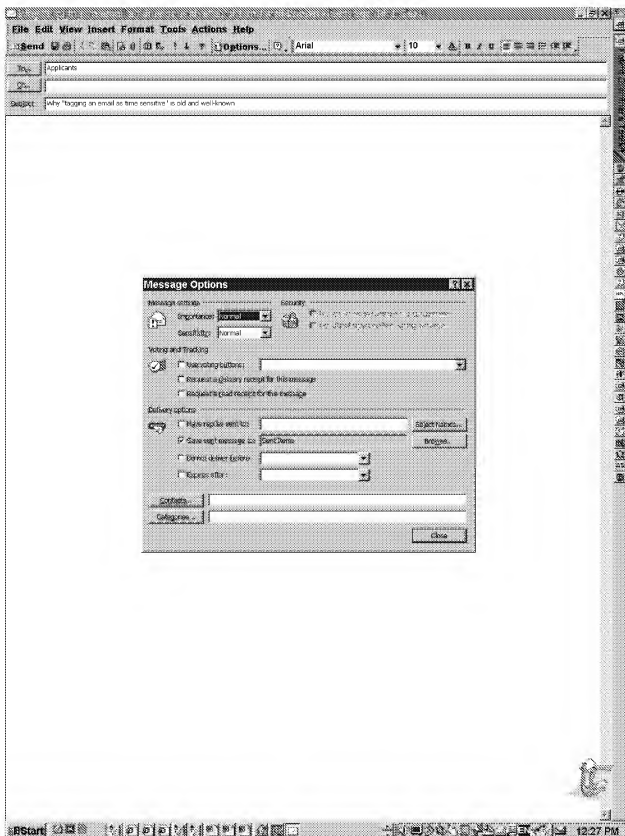
Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan as applied to claim 5 above, and further in view of the following.

The further difference between Hogan and the claimed subject matter is tagging selected emails as time sensitive.

However, tagging selected emails as time sensitive is old and well-known as evidenced by Microsoft Outlook, previously cited.

The following is a screenshot showing "Message Options" in Microsoft Outlook. One can set the "importance" of an email by checking either Normal, High, or Low. It is clear that emails with High Importance level will require attention in a more timely fashion than those with Low Importance level. In another word, the emails sent using Microsoft Outlook can be tagged as time sensitive.

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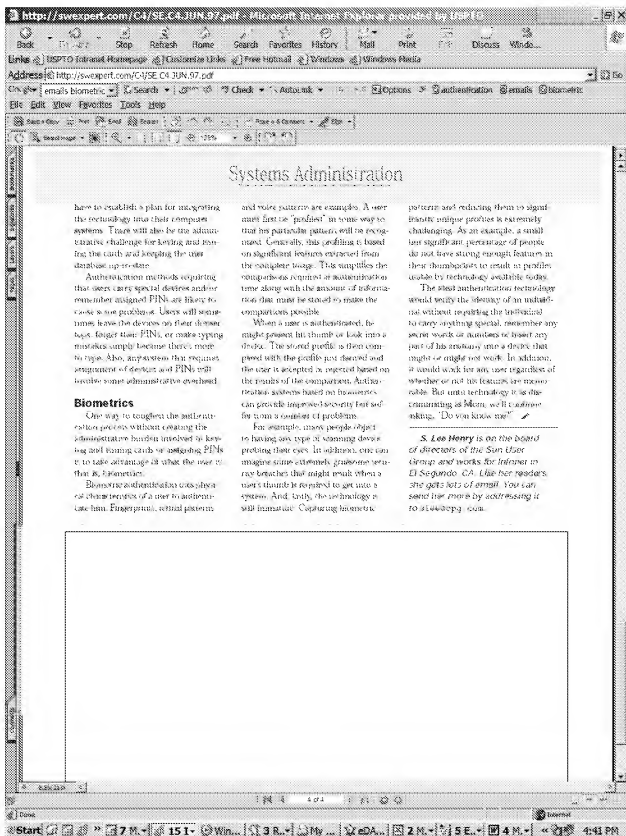
It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of tagging selected emails as time sensitive, since the Examiner takes Official Notice that tagging an email as time sensitive is old and well-known as evidenced by Microsoft Outlook; and providing the email server of Hogan with an option of tagging selected emails as time sensitive for emphasizing the importance of a particular email only involves ordinary skill in the art.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan as applied to claim 5 above, and further in view of the following.

The further difference between Hogan and the claimed subject matter is the use of biometric data for accessing to an electronic mailbox.

However, the use of biometric data for accessing to an electronic mailbox is old and well-known as evidenced by Blair, III, cited in the previous Office Action. Baird, III et al. discloses an apparatus and method using biometric authentication process to allow users' access to a server. Note that the term "server" clearly includes an email server. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of using biometric data for accessing to an electronic mailbox, since the Examiner takes Official Notice that biometric data is old and well-known as evidenced by "Authentication Basics" (1977), cited in previous Office Action. An example screenshot of the document is provided below:





Thus, it is clear that providing the email server of Hogan with an option of using biometric data for accessing to an electronic mailbox to provide further and more effective protection over conventional ID and password only involves ordinary skill in the art.

Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zoken.

Zoken discloses a method of storing an email in an electronic mailbox and mapping the email address of a recipient to a physical address of a recipient. However, Zoken does not disclose mapping the physical address of a recipient to the email address of a recipient.

However, mapping a physical address to an email address is old and well-known in the art as evidenced by Infospace, cited previously. Infospace provides an option of mapping a physical address to an email address; or in other words, searching a person's email address using a person's physical address in a data base comprising the person's physical address and email address.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Zoken with additional search capability such as mapping the physical address of a recipient to the email address of a recipient, since mapping a physical address to an email address or in other words, searching a recipient's email address using a recipient's physical address in a data base comprising a recipient's physical address and email address, is old and well-known in the art as evidenced by

Infospace, since the Examiner takes Official Notice that mapping a physical address to an email address; or in other words, searching a recipient's email address using a person's physical address in a data base is old and well-known as evidenced by at least Infospace, cited in the previous Office Action; and providing Zoken with an additional search capability only involves ordinary skill in the art to provide additional search capability to the Zoken.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Savino et al.

Savino et al. discloses a method for parcel delivery notification, comprising: receiving an electronic order for a parcel (received purchase order information); generating a parcel barcode representing at least a physical address of a buyer (see at least Fig. 5 and description thereof); scanning a parcel barcode (on a shipping label/packing slip); shipping the same parcel to a parcel delivery center; and scanning the same parcel barcode at said parcel delivery center.

Savino et al. does not disclose sending an email notification to a buyer when order is received and after shipment of order. Savino et al. also does not disclose mapping a physical address of a recipient to an email address of the recipient.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the steps of sending an email to a buyer after an on-line order is received and another email after the shipment of the order, since the Examiner takes Official Notice that sending email notification to a buyer after an on-line purchase

is a common practice in e-commerce. One who places an order with Amazon.com or Dell.com, for example, will receive a notification email after an on-line order is received and another email after the shipment of the on-line order.

The further difference between the claimed subject matter and that of Savino is the mapping a physical address of a recipient to an email address of the recipient.

However, mapping a physical address to an email address is old and well-known in the art as evidenced by Infospace, cited in the previous Office Action. Infospace provides an option of mapping a physical address to an email address; or in other words, searching a recipient's email address using a person's physical address in a data base comprising the person's physical address and email address.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of mapping a physical address to an email address; or in other words, searching a recipient's email address using a recipient's physical address in a data base comprising a recipient's physical address and email address, since the Examiner takes Official Notice that mapping a physical address to an email address; or in other words, searching a recipient's email address using a person's physical address in a data base is old and well-known as evidenced by at least Infospace, cited in the previous Office Action; and providing the Savino's mailing and delivering server(s) with such a search capability, since a search engine is important and vital to the success of e-commerce, only involves ordinary skill in the art.

***Response to Argument***

**The 35 USC 112 Rejection:**

In response to Appellants regarding claims 8 and 10, the Examiner maintains the rejection because the phrase ""sending an e-mail using physical address of a recipient" (claim 8) is unclear and misleading. It is common knowledge that one can only send emails using an email address, not a physical address. It is important to note that in claim 8, the step of "sending an email using a physical address" is performed before the step of "mapping said physical address of said recipient to an email address of said recipient." In claim 10, it is common knowledge that one can only send emails using an email address, not a physical address. The step of "mapping said physical address of said recipient to an email address of said recipient" cannot be found in claim 10. Without the step of "mapping," it is clear that the step of "sending an email address to a buyer... wherein a physical address of said buyer is used" cannot be performed.

**The 35 USC 103 Rejection:**

With regard to claims 1-5, 11, 13, 14, 16, and 17, Appellants argue that Hogan disclose a "subscriber's [or recipient's] personal data, including address and email,

are stored” and Hogan does not disclose “a means for mapping a physical address of a recipient to an email address of a recipient.”

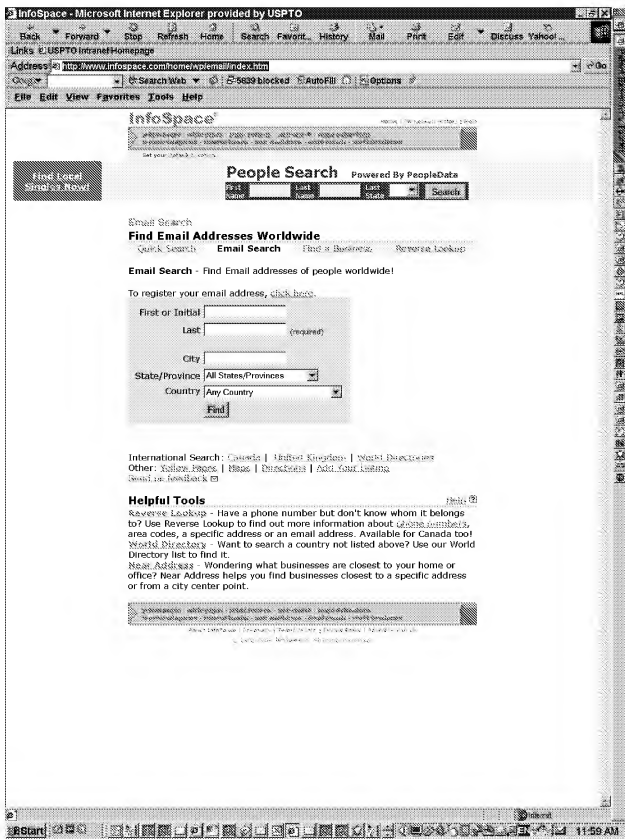
In response to Appellants' argument, it is well settled that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the rejection is based on a combination of Hogan and well-known prior art evidenced by documentary evidence (Infospace).

Appellants further argue that “[i]t seems quite clear that the element that the Examiner admits is missing from of the prior [Hogan] is not equivalent to the statement of Official Notice. Even if it were, there is not articulated motivation to combine them.”

Contrary to Appellants' argument, the Official Notice, used in the previous Office Action, was Official Notice supported by documentary evidence. It is clear that the rejection is NOT just simply based on a “statement of Official Notice” as alleged by Appellants, but rather a detailed statement of Official Notice supported by documentary evidence. In the instant case, the documentary evidence is a document from Infospace. Infospace provides an option of mapping a physical address to an email address; or in other words, searching a person's email address using a person's physical address in a database comprising the person's physical address and email address. It is noted that Appellants conceded that “Hogan discloses a “subscriber's [or recipient's] personal data, including address and email, are stored [in a data base].”

Appellants argue that "the Examiner takes Official Notice that searching for a particular predetermined information using a key word or phrase in a database is old and well known. The fact that searching a database is well known does not make it obvious to map a physical address to an e-mail address."

Contrary to Appellants' argument, the Official Notice is not just about "searching for a particular predetermined information using a key word or phrase in a database." The Official Notice is a detailed statement supported by documentary evidence. In the instant case, the documentary evidence is a document from Infospace. Infospace discloses searching for a predetermined information using a key word or phrase in a database. Specifically, Infospace provides an option of mapping a physical address to an email address; or in other words, searching a person's email address using a person's physical address in a database comprising the person's physical address and email address. The following is a screenshot showing a typical search engine mapping an email address to a physical address:





Infospace discloses searching for a predetermined information (email address) using a key words (physical address) in a database. It is clear that searching a person's email address using a person's physical address in a database comprising the person's physical address and email address is "mapping a physical address to an email address."

Appellants argue that "Appellants have respectfully requested that the Examiner provide a suggestion within the four corners of Hogan to use a physical address of a recipient to send an e-mail."

In response, Appellants seem to confuse between a 35 USC 102 rejection and a 35 USC 103 rejection. It is well settled that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the rejection is based on a combination of Hogan and well-known prior art evidenced by documentary evidence (Infospace).

Appellants also argue that "the Examiner has often jumped to the conclusion that combining two well known elements or process steps is obvious without any suggestion or motivation within the prior art. This is Impermissible. Where prior art references require a selective combination to render obvious a claimed invention, there must be some reason for the combination other than hindsight gleaned from the invention disclosure."

At the outset, it is well settled that there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Further, the rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988).

In addition, In response to Appellants' argument, a search engine is very important to the success of widely used e-commerce servers, such as Amazon.com or Dell.com, wherein one can search information on a product or service by using key

word(s) or phrase(s). Similarly, web sites, such as Yahoo.com, or Microsoft Msn.com, for example, provides useful search engines for users. In addition, Google.com provides users with a powerful search engine, wherein relevant information can be easily found using key word(s) or phrase(s). As a matter of fact, a search engine is so important that almost every e-commerce or public web site contains a search engine. There's no exception in the case of Infospace. Infospace provides a search engine to perform mapping a physical address to an email address; or in other words, searching a person's email address using a person's physical address in a database comprising the person's physical address and email address. Thus, it is clear that a search engine is very important to the success of e-commerce, and one of ordinary skill in the art would have recognized that a search engine, such as the one used in Infospace, is vital to Hogan's e-commerce. As clearly stated by the court, "[t]he strongest rationale for combining references is a recognition, expressly or impliedly in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, that some advantage or expected beneficial result would have been produced by their combination" (emphasis added). *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983). Clearly, the combination of the e-commerce server of Hogan and a search engine for mapping a physical address of a subscriber or recipient to an email address of the subscriber or recipient is an expected beneficial result.

With regard to claim 5, Appellants argue that “the cited references do not teach or fairly suggest at least the mapping function.” In response to Appellants’ argument, see discussion above.

With regard to claims 2, 3, 4, and 17, Appellants argue that “the Examiner has not articulated a rejection.” Contrary to Appellants’ argument, the basis of the rejection of claims 2-4, and 17, is clearly set forth in the rejection.

With regard to claim 6, as noted above, contains the same subject matter found in claim 3. Claim 6 does not contain limitation regarding selectively tagging or identifying a particular class of emails (as found in claim 7).

With regard to claim 7, Daniel, Jr. et al. discloses a method of sorting emails based on method of delivery and delivery designated emails via either postal mail or email (see at least Figs. 1 and 2, and description thereof). In particular, the printstream processor 102 selectively tags or identifies a particular class of emails based on the customer database delivery preference 202, for delivering either electronically via electronic inserter 110 or via traditional mail via physical inserter 106.

With regard to claims 8 and 9, Appellants argue that “Appellants respectfully disagree with the rejection for at least the reasons described above, especially with reference to claim 1.” In response to Appellants’ argument, see discussion above regarding claim 1. Further, as already discussed above, Daniel, Jr. et al. discloses a method of sorting emails based on method of delivery and delivery designated emails via either postal mail or email (see at least Figs. 1 and 2, and description thereof). In particular, the printstream processor 102 selectively tags or identifies a particular class

of emails based on the customer database delivery preference 202, for delivering either electronically via electronic inserter 110 or via traditional mail via physical inserter 106.

With regard to claim 12, Appellants argue that “Appellants respectfully disagree with the rejection for at least the reasons described above, especially with reference to claim 1.”

In response to Appellants’ argument, see discussion above regarding claim 1.

With regard to claim 15, Appellants argue that “Appellants respectfully disagree with the rejection for at least the reasons described above, especially with reference to claim 5.”

In response to Appellants’ argument, see discussion above regarding claim 5.

With regard to claims 5 and 13, Appellants argue that Zoken does not disclose “mapping a physical address of a recipient to an email address.”

In response to Appellants’ argument, it is well settled that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the rejection is based on a combination of Zoken and well-known prior art evidenced by documentary evidence (Infospace). See also discussion above with reference to claim 1.

With regard to claim 10, Appellants argue that Savino does not disclose mapping a physical address of a recipient to an email address, and use the obtained email address to send email.

In response to Appellants' argument, it is well settled that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the rejection is based on a combination of Savino and well-known prior art evidenced by documentary evidence (Infospace). See also discussion above with reference to claim 1.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dang whose telephone number is 571-272-3626.

The examiner can normally be reached on Monday-Friday from 9:AM to 5:PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on 571-272-3632. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Khanh Dang/

Primary Examiner, Art Unit 2111